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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/191,520	11/13/1998	JOHN S. HENDRICKS	SEDN/001SEDN	8726

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EXAMINER
KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/191,520	HENDRICKS ET AL.
Office Action Summary	Examiner	Art Unit	
	Andrew Y. Koenig	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *See Continuation Sheet* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/19/05*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 20060523

Continuation of Disposition of Claims: Claims pending in the application are 1-11,16,17,37,40,60,67-70,85,86,97,99,102,104,111,113,115,116,127-129,137-139,142-144,148 and 169-174.

Continuation of Disposition of Claims: Claims rejected are 1-11,16,17,37,40,60,67-70,85,86,97,99,102,104,111,113,115,116,127-129,137-139,142-144,148 and 169-174.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-11, 16, 17, 37, 40, 60, 67-70, 85,

86, 97, 99, 102, 104, 111, 113, 115-116, 127-129, 137-139, 142-144, 148, and 169-174

have been considered but are moot in view of the new ground(s) of rejection.

The applicant has traversed the following official notices:

Official Notice is taken that digital televisions are well known in the art

U.S. Patent 5,515,098 to Carles, already of record teaches a digital

television (col. 4, ll. 50-65).

Official Notice is taken that debiting accounts and charging credit cards is well

known in the art.

U.S. Patent 5,477,263 to O'Callaghan et al., already of record, teach

paying using a credit or debit card (col. 8, ll. 9-13).

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 142-144, and 148 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention.

Claims 70 and 138, there is not support in the specification as originally filed for a

program guide broadcast to the first terminal by the broadcaster, wherein the first

terminal selects programming for a second terminal. Whereas, the specification

teaches that the user may order from a location other than his home, such as at a kiosk

in a video rental store, or via the Internet (pg. 34, ll. 1-28), there is no support for the

details of broadcasting the guide to these locations as required in the claim.

For independent claim 142, the specification as originally filed fails to support

receiving a program order from a first terminal, the program order containing an address

of the first terminal and an address of a second terminal... generating an authorization

code... sending the generated authorization code to the first and the second terminals...

wherein the authorization code received by the first and the second terminals provide a

code that the first and the second terminals use to decrypt the program.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-3, 9, 16, 37, 40, 99, 102, 104, 111, 113, 127, 127-129, and 137-139 are

rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application

Publication 2003/0066085 to Boyer et al. (Boyer) in view of U.S. Patent 5,517,502 to Bestler et al. (Bestler).

Regarding claim 1, Boyer teaches a personal computer accessing a web page via the Internet for receiving program data (pg. 3, para. 0053, pg. 3, para. 0056, pg. 4, para. 0065, pg. 4, para. 0069), which reads on the claimed first receiver module that receives program data.

Boyer teaches ordering pay-per-view events via the web pages of the Internet, and having information sent to a headend (pg. 9, para. 0131-0133) and a separate television for receiving video signals (pg. 3, para. 0056, pg. 4, para. 0069), but is silent on a module for receiving a local authorization code, wherein the code allows the digital broadcast television programs to be decrypted for viewing. Bestler teaches conditional access (CA) packets multiplexed into the transport stream (claimed local authorization code) (col. 3, ll. 18-23) for decrypting the program, which reads on a second receiver module for receiving local authorization code, wherein the code allows the digital broadcast television programs to be decrypted for viewing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by a module for receiving a local authorization code, wherein the code allows the digital broadcast television programs to be decrypted for viewing as taught by Bestler in order to enable the system to decrypt the requested programs, thereby enabling the headend to authorize the display of the pay-per-view event. Boyer teaches a transmitting that sends a program selection to a remote site, wherein the program

selection is made from the program data received by the first receiver module and

contains address information (via entry of the telephone number and personal

identification number) of the second receiver module (pg. 9, para. 0131-0133); and

Boyer teaches the program selection is received at the remote site (pg. 9, para.

0131-0133) and Boyer recognizes that the web server can direct conventional

equipment at the headend to authorize the display of the ordered even (pg. 9, para.

0133), but is silent on a memory coupled to the second receiver module for storing the

received authorization code, and the remote site sends the local authorization code,

wherein the code is stored in memory until needed for decrypting the selected program

at a future time. Bestler teaches memory for storing the authorization code (col. 8, ll.

40-43) until needed for decrypting the program (col. 10, ll. 1-13). Bestler teaches the

decoder transmitting a program selection from the decoder to the controller (claimed

remote site) (fig. 7, lab 302) where the controller generates and sends the local

authorization code (col. 7, ll. 37-40, col. 11, ll. 51-61). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify

Boyer by a memory coupled to the second receiver module for storing the received

authorization code, and the remote site sends the local authorization code, wherein the

code is stored in memory until needed for decrypting the selected program at a future

time as taught by Bestler in order to store codes for use with decryption, thereby to

enable the system to selectively authorize devices for viewing programming thus

providing a revenue source for the headend.

Regarding claim 2, the combination of Boyer and Bestler has already been discussed; Bestler teaches a conditional access module (claimed second receiver) (fig. 1) and a processor for processing the code to decrypt the program (fig. 1, label 40)

Regarding claim 3, the combination of Boyer and Bestler teaches incorporating the components (processor, second receiver, and memory) within a set top terminal (Boyer: pg. 4, para. 0071), which is capable of being operably connected to a television.

Regarding claim 9, Boyer teaches the first receiver as a personal computer (fig. 1, label 40, fig. 3, label 106).

Regarding claim 16, the combination of Boyer and Bestler has already been discussed; Bestler teaches multiplexing the local authorization code with the program (col. 3, ll. 18-22).

Regarding claim 37, Boyer teaches the remote site comprises a web page of the Internet, wherein the page includes the program data and generates a request (pg. 4, para. 0067, pg. 9, para. 0131-0133).

Regarding claim 40, the combination of Boyer and Bestler has already been discussed; Bestler teaches an authorization code addressed to specific terminals (col.

8, II. 8-13) with an identification code identifies which programs the user is authorized to view (col. 9, II. 28-42).

Regarding claim 99, the limitations of claim 99 have been addressed in the discussion of claim 1. Claim 99 adds the limitation of displaying the program data as a program menu, which is taught by Boyer in at least figure 28.

Regarding claim 102, Boyer teaches data provided on an Internet web site.

Regarding claim 104, Boyer teaches that the program order is received at a remote location (pg. 9, para. 0132-0133)

Regarding claim 111, Boyer teaches that the program order is received at a remote location and sent to a digital programming broadcaster (pg. 9, para. 0132-0133).

Regarding claim 113, the combination of Boyer and Bestler has already been discussed; Bestler teaches multiplexing the local authorization code with the program (col. 3, II. 18-22).

Regarding claim 127, the limitations of claim 127 have been addressed in the discussion of claim 1.

Regarding claim 128, the combination of Boyer and Bestler has already been

discussed; Bestler teaches multiplexing the local authorization code with the program

and demultiplexing (col. 3, ll. 18-22).

Regarding claim 129, Boyter teaches a remote site transmitting the authorization

signal to a broadcast (pg. 9, para. 0132-0133), wherein the broadcaster broadcasts the

multiplexed digital programs as discussed with Bestler.

Regarding claim 137, Boyer teaches generating a program guide and

transmitting the guide, wherein selections are made based upon the guide (see fig. 27-

28, 31).

Regarding claim 138, Boyer teaches the guide is broadcast to the first terminal.

Regarding claim 139, Boyer teaches the guide is broadcast to the first terminal.

6.   Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent Application Publication 2003/0066085 to Boyer et al. (Boyer) and U.S.

Patent 5,517,502 to Bestler et al. (Bestler) in view of U.S. Patent 5,600,364 to

Hendricks et al. (Hendricks '364).

Regarding claim 4, Boyer teaches a television (see fig. 1, label 54, fig. 3, label 120), Bestler teaches a connection to a video display (col. 3, II. 31-38), which displays the analog image. However, Boyer and Bestler are silent on displaying on an analog television. Hendricks '364 teaches converting a compressed image to analog to be displayed on the television (col. 7, II. 48-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by displaying the decompressed images on the television as taught by Hendricks '364 in order to effectively display the images and information to the user.

Regarding claim 17, Boyer and Bestler are silent on teaching a remote control and the details of a menu and scrolling the program guide for a desired programming. Hendricks '364 teaches a remote control and navigating through a program guide for desired programming (col. 12-13, II. 65-5; col. 13, II. 23-38). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by using a remote control and navigating through a program guide as taught by Hendricks '364 in order to provide a more user friendly environment for choosing desired programs.

7.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0066085 to Boyer et al. (Boyer) and U.S. Patent 5,517,502 to Bestler et al. (Bestler) in view of U.S. Patent 5,880,769 to Nemirofsky et al.

Regarding claim 5, Bestler teaches a conditional access unit but Boyer and Bestler are silent on a smart card. Nemirofsky teaches using a smart card and transmitter in a smart card (col. 2, ll. 45-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by implementing a smart card with a transmitter as taught by Nemirofsky in order to maintain security and automate transactions.

Boyer is silent on a digital television. Official Notice is taken that digital televisions are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by using a digital television in order to provide an integrated digital system thereby reducing the number of components.

8.   Claims 6-8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0066085 to Boyer et al. (Boyer), U.S. Patent 5,517,502 Bestler et al. and U.S. Patent 5,880,769 to Nemirofsky et al. in view of U.S. Patent 5,809,204 to Young et al.

Regarding claim 6, Boyer and Bestler are silent on second receiver incorporated into the digital television. As discussed in claim 5, the examiner asserts that digital televisions are well known in the art. Furthermore, Young teaches that integrating components is well known (col. 12, ll. 48-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by

integrating the first receiver of Bestler into a digital television in order to provide an integrated digital system thereby reducing the number of components.

Regarding claim 7 and 8, claim 7 introduces a third receiver but the examiner notes that it is substantially similar to that of Bestler except that the location is in the digital television. Accordingly, the limitations of claims 7 and 8 have been addressed in the discussion of claims 5 and 6.

Regarding claim 10, the limitations of claim 10 have been addressed in the discussion of claim 6.

Regarding claim 11, the limitations of claim 11 have been addressed in the discussion of claims 6 and 9.

9.   Claims 67-70, 85, 97, and 169-174 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0066085 to Boyer et al. (Boyer) in view of U.S. Patent 5,600,364 to Hendricks et al. (Hendricks '364) and U.S. Patent 5,517,502 to Bestler et al. (Bestler).

Regarding claim 67, Boyer teaches order and account verification information being processed, which inherently has a system to perform the functions, wherein the system receives the requests from a personal computer accessing a web-page (pg. 4, para. 0069, pg. 9, para. 0132), which equates to an order and authorization system that receives a program order from a first terminal in a television distribution network and generates an authorization order that authorizes access to a program.

Boyer teaches a headend authorizing display of the ordered event (pg. 9, para.

0133), but is silent on a billing system coupled to the order an authorization system,

wherein the billing system receives the order and generates a billing record. Hendricks

'364 teaches a billing system coupled to an order and authorization system, and the

billing system receives the orders and generates a billing record (col. 40, ll. 21-29).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Boyer by a billing system coupled to the order an

authorization system, wherein the billing system receives the order and generates a

billing record as taught by Hendricks '364 in order appropriately charge customers for

their respective services.

Boyer teaches a headend coupled to the order and authorization system, and

seconding the program to a second terminal (set top box) in the television distribution

network (pg. 9, para. 0132-0133), but is silent on how the data is sent to the second

terminal, specifically, Boyer is silent on the program is multiplexed with other programs,

the authorization providing a local authorization code addressed to the second terminal,

wherein the authorization code allows the terminal to demultiplex, decrypt and display

the program. Bestler teaches a cable decoder (fig. 1) for receiving a digital broadcast

television program (col. 2, ll. 55-67). Furthermore, Bestler teaches receiving programs

(claimed program data) (col. 3, ll. 1-17, col. 4, ll. 17-20), and conditional access (CA)

packets multiplexed into the transport stream (claimed local authorization code) (col. 3,

ll. 18-23) for decrypting the program. Additionally, Bestler teaches memory for storing

the authorization code (col. 8, ll. 40-43) until needed for decrypting and displaying the

program (col. 10, ll. 1-13). Bestler teaches the decoder transmitting a program selection

from the decoder to the controller (claimed remote site) (fig. 7, lab 302) where the

controller generates and sends the local authorization code (col. 7, ll. 37-40, col. 11, ll.

51-61). Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Boyer by multiplexed the program with other

programs, the authorization providing a local authorization code addressed to the

second terminal, wherein the authorization code allows the terminal to demultiplex,

decrypt and display the program as taught by Bestler in order to provide secure

transmission of content.

Regarding claim 68, Bestler teaches multiplexing the local authorization code

with the program and demultiplexing (col. 3, ll. 18-22).

Regarding claim 69, Bestler teaches an authorization code addressed to specific

terminals (col. 8, ll. 8-13) with an identification code identifies which programs the user

is authorized to view (col. 9, ll. 28-42).

Regarding claim 70, Boyer teaches the program is listed in the program guide to

the first terminal by the broadcaster (fig. 1 and 3).

Regarding claim 85, Boyer is silent on debiting accounts and credit cards,

however, Official Notice is taken that debiting accounts and charging credit cards is well

known in the art. Therefore, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Boyer by debiting accounts and

charging credit cards in order to permit the user to easily purchase services.

Regarding claim 97, the combination of Boyer and Bestler has already been

discussed; Bestler teaches an authorization code addressed to specific terminals (col.

8, ll. 8-13) with an identification code identifies which programs the user is authorized to

view (col. 9, ll. 28-42).

Regarding claim 169, the limitations of claim 169 have been addressed in the

discussion of claim 67.

Regarding claims 170 and 171, the combination of Boyer and Bestler has already

been discussed; Bestler teaches multiplexing the local authorization code with the

program and demultiplexing (col. 3, ll. 18-22).

Regarding claims 172-174, Boyer teaches the the program is listed in an

electronic program guide provided on a web page of the Internet, wherein the terminal

accesses the web page to receive the web page (pg. 4, para. 0067-0068, fig. 15-34).

10.   Claims 60 and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent Application Publication 2003/0066085 to Boyer et al. (Boyer) and U.S.

Patent 5,517,502 Bestler et al. in view of U.S. Patent 5,734,853 to Hendricks et al.
(Hendricks '853).

Regarding claim 60, Boyer is silent on a time out feature, Hendricks '853 teaches
a time out (fig. 19, 20, col. 37, ll. 20-25). Therefore, it would have been obvious to one
of ordinary skill in the art at the time the invention was made to modify Boyer by using
time outs as taught by Hendricks '853 to deauthorize the display and prevent charges.

Regarding claim 115, Boyer is silent on a time out period and if the cancel order
is not received within the time out period, sending the program order to billing system,
and preparing billing. Hendricks '853 teaches a time out period and if the cancel order is
not received within the time out period, then billing the user which clearly sends the
program order to billing system, and preparing billing (col. 37, ll. 20-25). Therefore, it
would have been obvious to one of ordinary skill in the art at the time the invention was
made to modify Boyer by a time out period and if the cancel order is not received within
the time out period, sending the program order to billing system, and preparing billing as
taught by Hendricks '853 in order to appropriately bill users when the program has been
watched past a threshold amount.

11.   Claims 86 and 116 rejected under 35 U.S.C. 103(a) as being unpatentable over
U.S. Patent Application Publication 2003/0066085 to Boyer et al. (Boyer) and U.S.
Patent 5,517,502 Bestler et al. in view of U.S. Patent 5,734,853 to Hendricks et al.
(Hendricks '853) and U.S. Patent 5,600,364 to Hendricks et al. (Hendricks '364).

Regarding claim 86, Boyer is silent on the time out feature. Hendricks '853 teaches a time out and teaches canceling the program for a time prior to the start and after the start of the program (fig. 19, 20, col. 37, ll. 20-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by using a time out feature prior to displaying and after the start of the program as taught by Hendricks '853 in order to inhibit unauthorized viewing of programs.

Regarding claim 116, Boyer is silent on a time out period, and generating a deauthorization signal if the cancel order is received, and transmitting the deauthorization signal which removes access to a previously authorized program. Hendricks '853 teaches a time out period. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer by a time out period as taught by Hendricks '853 in order to permit the user to escape from an ordered movie without charge. Boyer and Hendricks '853 are silent on a deauthorization signal which removes access to a previously authorized program. Hendricks '364 teaches transmitting the deauthorization signal which removes access to a previously authorized program (col. 32, ll. 7-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boyer and Hendricks '853 by a deauthorization signal which removes access to a previously authorized program as taught by Hendricks '364 in order to prevent a cancelled program from being viewed by a subscriber who has already received the authorization for the program.

Conclusion

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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ayk

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